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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/506,907	09/07/2004	Noriko Shimozone	Q83226	6781

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SUGHRUE MION, PLLC
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EXAMINER

CHU, YONG LIANG

ART UNIT	PAPER NUMBER
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1626

MAIL DATE	DELIVERY MODE
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12/20/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/506,907	Applicant(s) SHIMOZONO ET AL.	
	Examiner Yong Chu	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-12, and 14 is/are pending in the application.
- 4a) Of the above claim(s) 3, 4, 7-9 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 5-6, 10, and 12 is/are rejected.
- 7) ☒ Claim(s) 2, 5, 6, 10, 12 and 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1 and 13 have been cancelled by the Amendment filed on 11/13/2007. Claim 14 is new by the Amendment. Therefore, claims 2-12, and 14 are pending in the instant application. Claims 3-4, 7-9, and 11 remain withdrawn as non-elected subject matter. Therefore, claims 2, 5-6, 10, 12, and 14 will be examined on the merits.

Response to Amendment

The Amendment by Applicants' representative Ms. Keiko K. Takagi dated on 11/13/2007 has been entered.

Response to Arguments

Election of Species and Restriction/Election

The examiner has objected to claims 1, 2, 6, 12, and 13 for containing elected and non-elected subject matter. The elected and examined subject matter have been identified at the previous Office action dated on 05/10/2007.

In response, Applicant argues that "since there are no prior art rejections, the claims should not be limited to the elected species and the search should be extended. See MPEP 803.02", on page 12 under REMARKS dated on 05/10/2007. Applicant's argument has been fully considered, and is found not persuasive. Applicant treated the elected and examined subject matter shown at the previous Office as the elected species. The Office can not agree with Applicant's argument, because it is a quite broad patentably distinct sub-genus, which encompasses the elected species. Actually,

the examiner has extended the search and examination much beyond the elected species. It would be serious burden for examiner to search and examining the entire application especially in considering the several provisos, which excludes sub-genus. In addition, the current comprises multiple independent inventions, wherein Y^1 and Y^2 are a cycloalkyl group, a lower cycloalkenyl group, a phenyl group, a naphthyl group, a heteroaryl group, or an aliphatic hetero ring as been examined distinct from the remaining non-elected group with Y^1 and Y^2 as a lower alkenyl, a lower alkynyl group, or a group represented by formula (4). To include the other groups, it requires additional database search and examination. Therefore, the restriction requirement is indeed appropriate, and is made FINAL.

Rejection under 35 U.S.C. §112, 2nd paragraph

Applicant's amendment and arguments over rejection of claims 1-10, and 12-13 under 35 U.S.C. §112, 2nd paragraph have been considered, but are found not persuasive. Applicant's argument is on the ground that "the one ordinary skilled in the art would understand that "may be substituted" means that each of Y^1 and Y^2 is either substituted or unsubstituted". This argument has been fully considered, and is found not persuasive. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, Applicant needs to clearly define each of the substituents in the formula to clearly point out their invention, compounds or compositions as their invention.

Because the amended claim 12 does not defined a phenyl group, a naphthyl group, or a heteroaryl group maybe substituted by which function group, it renders claims 2, 5, 6, 10, and 12 indefinite.

Claim Objections

Claims 2, and 5-6 are objected to because they depend on Claim 12, a subsequent claim. A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

Claims 2, 5-6, 10, 12, and 14 are objected to for containing elected and non-elected subject matter. The elected subject matter has been identified in the previous Office action dated on 05/10/2007.

This application contains claims 2, 5-6, 10, 12, and 14 drawn to an invention nonelected with traverse in Reply filed on October 6 2006. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Conclusion

- Claims 2, 5-6, 10, and 12 are rejected.
- Claims 2, 5-6, 10, 12, and 14 are objected to.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Chu whose telephone number is 571-272-5759. The examiner can normally be reached on 7:00 am - 3:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Application/Control Number:
10/506,907
Art Unit: 1626

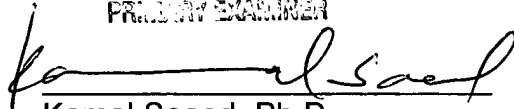
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you have questions on access to the Private PAIR system, contact the Electronic
Business Center (EBC) at 866-217-9197 (toll-free).



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